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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No.	:	09/542,109
Confirmation No.	:	4187
Applicant	:	Kight et al.
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TC/A.U.	:	3625
Examiner	:	Yogesh C. Garg
Customer No.	:	20457

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APPEAL BRIEF

Honorable Assistant Commissioner
  for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

August 29, 2003

Sir:

This Appeal Brief is submitted in support of the Notice of Appeal filed June 30, 2003.

I. REAL PARTY IN INTEREST

CheckFree Corporation is the real party in interest.

II. RELATED APPEALS AND INTERFERENCES

Application Serial Number 09/541,362 [Attorney Docket 3350-031D], filed March 31, 2000 and entitled "Bill Payment System and Method Utilizing a Draft", Application Serial Number 09/540,011 [Attorney Docket 3350-031F], filed March 31, 2000 and entitled "Bill Payment System and Method With a Master Merchant Database", and

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Application Serial Number 09/250,711 [Attorney Docket 3350-031B], filed February 16, 1999 and entitled "System and Method for Electronically Providing Customer Services Including Payment of Bills, Financial Analysis and Loans", all of which have parentage similar to that of the present application, are currently subject to appeal.

III. STATUS OF CLAIMS

Claims 36, 38-40, 42-44, 46-48, 50-56 and 58-61 are pending in this application, each of which is under appeal.

IV. STATUS OF AMENDMENTS

An Amendment was filed on November 29, 2002. The amendment has been entered. Requests for Reconsideration were filed on April 30, 2003, and June 30, 2003.

V. SUMMARY OF INVENTION

A preferred embodiment of the present invention is shown in Figures 1-6, and described in the related disclosure on page 5, line 2, through page 16, line 4.

In accordance with claim 36, consumer banking information is processed by storing a plurality of routing numbers associated with a plurality of financial institutions, typically bank routing transit numbers (RTN's), in a financial institutions file, FIF 24 of Figure 1 (see page 5, lines 18-20). A routing number associated with a financial institution at which a consumer maintains a deposit account is received, e.g. via authorization form 20 and a voided check (see page 5, lines 2-10 and 16-17). The received routing number is compared to the stored plurality of routing numbers in the financial institutions file, FIF 24, to verify accuracy of the received routing number (see page 5, lines 17-18, and page 5, line 20 through page 6, line 5).

According to claim 38, the received routing number is rejected if the accuracy is not verified because the received routing number does not correspond to one of the stored plurality of routing numbers in the financial institutions file (see page 6, lines 1-2).

Claim 39 requires that the received routing number be entered, e.g. via data

entry 52, and that the comparison also verifies that the received routing number is entered correctly (see page 6, lines 1-2).

According to claim 40, a request to pay a bill associated with a merchant on behalf of the consumer is received, e.g. the make payment request 36 of Figure 2 (see page 7, lines 14-16). A determination is made as to whether the consumer financial institution accepts electronic fund transfers (EFTs), such as ACH transfers, based on the verified routing number, in 62 of Figure 4A (see page 9, lines 12-19 and page 11, lines 14-16). An instruction to pay the bill by electronic fund transfer (EFT), from the consumer deposit account is generated in 47,72 of Figure 4C, if the consumer financial institution is determined to accept electronic fund transfers (see page 12, lines 6-18 and page 14, lines 7-11).

According to claim 42, a request is received to pay a bill associated with a merchant on behalf of a consumer. A routing number, e.g. RTN, associated with a financial institution at which the consumer maintains a deposit account is also received. The received routing number is compared to routing numbers associated with a plurality of financial institutions in a financial institutions file (FIF) to verify the accuracy of the received routing number. If it is determined that the consumer financial institution accepts electronic fund transfers (EFTs), e.g. ACH transfers, based on the verified routing number, an instruction to pay the bill by electronic fund transfer (EFT) from the consumer deposit account is generated.

In accordance with claim 43, determining if a financial institution can process electronic fund transfers (EFTs) is accomplished by storing a plurality of routing numbers, e.g. RTNs, associated with a plurality of financial institutions in a financial institution database. A routing number associated with a financial institution is compared to the plurality of routing numbers in the financial institution database to verify correctness of the routing number. The determination as to whether the financial institution accepts electronic fund transfers (EFTs) is made based on the verified routing number.

According to claim 60, to process a payment request, a request to pay a bill associated with a merchant on behalf of the consumer is received. A routing number, e.g. RTN, associated with a financial institution at which the consumer maintains a

deposit account is also received. If the consumer financial institution is determined to accept electronic fund transfers (EFTs), e.g. ACH transfers, based on the received routing number, an instruction to debit the consumer deposit account by electronic fund transfer (EFT) is generated in order to process the received pay request.

Claims 44, 46-48 and 50-51 are directed to systems in accordance with the present invention. These systems include features including a storage device, such as FIF 24 of Figure 1; a processor, such as the processor of computer 46 of Figures 5 and 6; a data entry device, such as the keyboard or mouse of the PC 37 of Figure 6; and a network interface, such as the front end processor 40 of Figure 6 (see page 9, lines 19-20 and page 10, lines 3-6).

Claims 52-56, 58 and 59 are directed to software implementations of the present invention.

VI. ISSUES

Weather claims 36, 38 and 39 are obvious, under 35 USC §103(a), over Braum, et. al. (U.S. Patent No. 4,321,672) in view of Jan Paschal article entitled "NEW EDITION OF RAND MCNALLY BANKERS DIRECTORY AVAILABLE"; and whether claims 40, 42-44, 46-48, 50-56 and 58-61 are obvious, under 35 USC §103(a), over the base combination, in further view of Lawlor (U.S. Patent No. 5,220,501) and Case (U.S. Patent No. 4,270,042.

VII. BRIEF DESCRIPTION OF THE REFERENCES

BRAUM

Braum has the objective of reducing processing expense and time, and making the processing more efficient. As described in columns 11 and 12, Braum accomplishes these objectives by having a user enter an MICR encoded account number (which includes a routing number) at an ATM machine. This information is then routed to the user's financial institution. That is, Braum directs the routing numbers furnished by a customer to the customer's financial institution for verification. The routing number is checked, by the customer's financial institution, against stored

information representing account numbers for accounts at that financial institution, to verify the received account number, including a routing number. Thus, according to Braum the verification of a routing number is performed by the financial institution to which that routing number relates.

PASCHAL

Paschal discloses that a directory of active and retired bank (ABA) routing numbers has been published by Rand McNally since 1911.

LAWLOR

According to Lawlor, home banking systems using PC's operating special purpose software have been unsuccessful for various reasons (see column 1, line 20, through column 2, line 68). Lawlor discloses that it had been previously proposed to provide bill paying services using the ATM and ATM/POS networks (see column 5, lines 8-19), but that a practical architecture for providing comprehensive banking services, including paying bills to user selected payees, from one's home or office over standard telephone lines has yet to be proposed (see column 6, lines 31-36). It should be noted that ATM and ATM/POS networks will sometimes generally be referred to as ATM networks herein.

Lawlor proposes to solve this problem by a new use of the existing ATM networks to provide transactions not previously supported by such networks, e.g. home initiated bill payment transactions (see column 7, lines 37-48). Hence, it is an express objective Lawlor to use the existing ATM networks to effectuate bill payment from one's home or office.

According to Lawlor, consumer directed financial transactions are executed by a central computer in direct communication with the consumer's bank via an ATM network (see column 11, lines 25-31). In column 11, lines 43-55, Lawlor teaches that the financial institute at which the payer utilizing the Lawlor system maintains a deposit account must accept electronic fund transfers (via ATM).

The central computer accesses and debits the consumer's account for the amount of a bill-pay request via the ATM network. This accessing and debiting is done

in real-time (see column 22, lines 32-37 and column 49, lines 18-46). This accessing and debiting is identical to that performed via any conventional ATM or ATM/POS network, using a conventional ATM machine or ATM/POS device. Thus, from a consumer bank's perspective, the central computer looks and behaves like any node on an ATM network (see column 18, lines 35-38, column 33, lines 23-55, and column 42, lines 18-23). Lawlor thereby meets the objective of capitalizing on the widespread familiarity with the ATM network and avoiding training etc., which Lawlor viewed as otherwise necessary if ATM networks were not utilized (see column 6, lines 45-55).

Lawlor discloses a system which is specifically designed to use existing ATM networks to effectuate bill payment, see column 6, lines 65-68. Consumer directed financial transactions are executed by a central computer in direct communication with the consumer's bank via an ATM network, see column 11, lines 25-31. The central computer accesses and debits the consumer's account for the amount of a bill-pay request via the ATM network. This accessing and debiting is done in real-time, see column 22, lines 32-37, and column 49, lines 18-46, and is the same accessing and debiting performed via any ATM network.

After debiting funds from a consumer's account, a payment is made to a merchant. The funds debited from the consumer's account by the central computer are credited to a deposit account belonging to the service provider controlling the central computer. This service provider then pays the specified merchant by one of a check or electronic funds transfer from funds of the service provider, column 49, lines 24-25. Payment to the merchant is always performed subsequent to debiting funds from the consumer. Lawlor suggests that payments to a single merchant on behalf of many consumers may be made by a single payment, column 33, lines 63-64.

As disclosed in column 42, line 60, to column 43, line 68, a payer selects a payee to whom payment is to be made and a determination is then made as to whether or not the payer has previously made a payment to that payee. According to column 49, lines 17-40, the processing performed, after a payer requests that a payment be made, includes the debiting of a payer's deposit account via an ATM or ATM/POS network in favor of a holding account associated with the service provider (see lines 17-

25). Thereafter, a credit, either in the form of a check or an ACH transfer, is instituted to pay the payee (see lines 36-40). This credit is drawn on an account associated with the service provider, not on the payer's deposit account.

However, as disclosed, the payer's account could, if desired, be debited in favor of an account associated with the payee. That is, the funds debited from a payer's account via an ATM network, could be immediately credited to an account associated with the payee via the ATM network, thereby eliminating the need for any intermediate account. However, if ATM debiting and crediting is utilized, a consolidated payment cannot be made, since consolidated payments require an intermediate account.

In summary, Lawlor discloses that a need existed for a practical architecture for providing comprehensive banking services, including paying bills to user selected payees, from one's home or office over standard telephone lines (see column 6, lines 31-36). According to Lawlor, home banking systems using standard PC's operating special purpose software have been unsuccessful for various reasons. Lawlor goes to great lengths to describe why existing systems, which do not utilize the existing ATM or ATM/POS networks, were unsuccessful (see column 1, line 20, through column 2, line 68, and column 6, lines 31-36).

In Lawlor's view, the need for a practical architecture can be met by capitalizing on the widespread familiarity with ATM and ATM/POS networks, and thereby avoiding training etc. which Lawlor viewed as otherwise necessary if ATM or ATM/POS networks were not utilized (see column 6, lines 45-55). Therefore, Lawlor has the explicit objective of providing bill paying services using the existing ATM and ATM/POS networks (see column 5, lines 8-19).

Lawlor proposes to meet this objective by disclosing a new use for the existing ATM and ATM/POS networks to provide transactions not previously supported by such networks, e.g. home initiated bill payment transactions and particularly the debiting of the payer's account in connection therewith (see column 7, lines 37-48).

CASE

As disclosed by Case in column 4, line 26, through column 5, line 22, if electronic.

fund transfer (EFT) is desired an account holder punches at the time of a transaction, or pre-punches, element 37 of the draft to be used to pay a bill, as depicted in the portion of the draft detailed in Figure 3A. Case also discloses that block 57 of the draft, as depicted in Figure 3, contains the ABA routing number. As disclosed by Case in column 7, lines 53-56, if the element 37 is punched, the funds from the deposit account of the account holder will automatically be debited by electronic funds transfer (EFT). Case lacks any disclosure of verification of the routing number in block 57 or of the utilization thereof for determining if the account holder's financial institution accepts electronic fund transfers (EFTs).

VIII. THE REJECTION

In the final Official Action dated February 28, 2003, (i) the claim of priority to 1991 is denied, (ii) claims 36, 38-40, and 42 stand rejected under 35 USC §101, as directed to non-statutory subject matter, (iii) claims 36, 38 and 39 stand rejected under 35 USC §103(a), as obvious over Braum, et. al. (U.S. Patent No. 4,321,672) in view of Jan Paschal article entitled "NEW EDITION OF RAND MCNALLY BANKERS DIRECTORY AVAILABLE"; and (iv) claims 40, 42-44, 46-48, 50-56 and 58-61 stand rejected under 35 USC §103(a), as obvious over the base combination, in further view of Lawlor (U.S. Patent No. 5,220,501) and Case (U.S. Patent No. 4,270,042.

In a first Advisory Action dated June 3, 2003, the rejection of claims 36, 38-40, and 42 under 35 USC §101 is withdrawn in view of the traversal arguments presented in the Request for Reconsideration filed on April 30, 2003.

In a second Advisory Action dated July 15, 2003, the denial of the claim of priority to 1991 is withdrawn in view of the traversal arguments presented in the Request for Reconsideration filed on June 30, 2003.

In rejecting the claims 36, 38 and 39 as obvious over the applied prior art, the Examiner contends that Braum discloses the claimed invention (citing column 11, line 50, through column 12, line 8, column 1, lines 5+, column 16, lines 61-66 and Figure 7), except (i) the required storage of a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required

comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number. To overcome this deficiency, the Examiner proposes to modify Braum to include the required financial institutions file and to perform the comparison of a received routing number with the routing numbers stored in such a file in order to verify the accuracy of the received routing number, based on Paschal's disclosure (citing page 1, last paragraph, through page 2, second paragraph) of a directory of active and retired bank routing numbers published by Rand McNally.

The Examiner contends that "it would have been obvious ... to modify Braum to include Rand McNally's directory of both active and retired routing numbers to verify the accuracy of the routing number from a customer". The Examiner asserts that this modification is motivated because it "would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is active or retired or incorrect routing number".

In rejecting the claims 40, 42-44, 46-48, 50-56 and 58-61 as obvious over the applied prior art, the Examiner acknowledges that the base combination fails to disclose the required (i) receiving of a request to pay a bill associated with a merchant on behalf of a consumer, (ii) determining if the consumer financial institute accepts electronic fund transfers based on the verified routing number and (iii) generating of an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers (EFT), of claim 40. Claims 42-44, 46-48, 50-56 and 58-61 are not separately addressed.

The Examiner proposes to modify the base combination in view of the teachings of Lawlor (citing column 10, line 66, through column 12, line 3) and Case (citing column 4, line 61, through column 5, line 2, column 5, line 54, through column 6, line 26, column 7, lines 13-56, column 9, lines 13-34, and Figures 3 and 3A) to cure this deficiency. The Examiner asserts that it would have been obvious to those skilled in the art to modify the base combination "to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network

and generate payment instructions via electronic funds transfer if feasible." According to the Examiner, "[d]oing so would benefit consumers to implement bill payments electronically from home and benefit payees by cutting down their processing costs, float, offering more predictable cash flow as explicitly disclosed by Lawlor".

Furthermore, the Examiner asserts that Case teaches a determination as to whether or not the consumer's financial institution accepts electronic fund transfers, based on a verified routing number (citing column 4, line 61, through column 5, line 2). The Examiner contends that it was obvious to further modify the base combination (as modified by Lawlor) in accordance with Case to "include the feature of determining if electronic funds transfer can be made based on the verified routing numbers". The Examiner alleges that this is motivated because "[d]oing so would help the method of Braun/Paschal/Lawlor to determine if the payment is feasible by electronic funds transfer or via paper as suggested in both Lawlor (see at least col. 11, lines 55-60) and Case (col. 5, line 54-col. 6, line 9)".

In the Advisory Action of June 3, the Examiner responds to the previously submitted arguments traversing the prior art rejections (including those highlighting inconsistencies between the Examiner's assertions and explicit teachings within the applied prior), by stating only that the Examiner "does no[t] agree as Braun/Paschal teaches the limitations of claims 36, 38 and 39 as analyzed in the final Office action, paper #12" and "Lawlor/Case teaches the limitation of claim 40 as analyzed in the final Office action, paper #12".

IX. GROUPING OF CLAIMS

Appealed claims 36, 42, 43, 44, 50, 51, 52, 58, 59 and 60 are independent. Claims 38-40 depend from claim 36; claims 46-48 depend from claim 44; claims 53-56 depend from claim 52; and claim 61 depends from claim 60.

However, the claims do not stand or fall together. Each of claims 36, 38, 39, 40, 42, 43, 44, 46, 47, 48 50, 51, 52, 53, 54, 55, 56 58, 59, 60 and 61 recites one or more features that form an independent basis for allowance. Hence, each of the appealed claims (i.e. each of claims 36, 38, 39, 40, 42, 43, 44, 46, 47, 48, 50, 51, 52, 54, 55, 56,

58, 59, 60 and 61) stands and falls alone.

X. ARGUMENT

Appellant respectfully traverses the rejections based on the prior art applied against the claims now pending and under appeal. As discussed below in detail, it is respectfully submitted that the final rejection lacks the requisite supporting factual basis and/or reasonable rationale, effectively ignores recited limitations, and construes the relied upon art in a manner inconsistent with its own teaching, and thus fails to meet the burden of proof in establishing that the appealed claims are obvious. It is further respectfully submitted that the rejection relies upon art that has been combined without any motivation to do so. Further still, it is respectfully submitted that the art applied in rejecting the claims neither teaches nor suggests the claimed invention. It is also respectfully submitted that, in view of the record in this case, the rejection is at best based on an improper hindsight reconstruction of the claimed invention.

Claims 36, 38 and 39 stand rejected under 35 USC §103(a), as obvious over Braum, et. al. (U.S. Patent No. 4,321,672) in view of Jan Paschal article entitled "NEW EDITION OF RAND MCNALLY BANKERS DIRECTORY AVAILABLE". Claims 40, 42-44, 46-48, 50-56 and 58-61 stands rejected under 35 USC §103(a), as obvious over the base combination, in further view of Lawlor (U.S. Patent No. 5,220,501) and Case (U.S. Patent No. 4,270,042.

1. THE EXAMINER HAS FAILED TO ESTABLISH A PRIMA FACIE CASE

The initial burden of establishing a basis for denying patentability to a claimed invention rests upon the examiner. In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Thorpe, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985); In re Piasecki, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). The examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966).

Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir.

1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Furthermore, as the Federal Circuit has recently reiterated, reliance on common knowledge and/or common sense cannot be the basis of a finding of non-patentability, In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002), and the deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

Rather, the Examiner must provide sufficient factual basis or rationale as to how features of the invention recited in the claims are taught or suggested in the applied art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988), and without such evidence the rejection is improper per se.

It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

The limitations required by the claims cannot be ignored. See In re Wilson, 424 F.2d 1382, 165 USPQ 494 (CCPA 1970). All claim limitation, including those which are functional, must be considered. See In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981). Hence, all words in a claim must be considered in deciding the patentability of that claim against the prior art. Each word in a claim must be given its proper meaning, as construed by a person skilled in the art. Where required to determine the scope of a recited term, the disclosure may be used. See In re Barr, 444 F.2d 588, 170 USPQ 330

(CCPA 1971).

It is respectfully submitted that the Examiner has failed to establish a prima facie case for the rejection. More particularly, the Examiner has failed to provide objective support or a reasonable rationale for the rejections, has effectively ignored limitations recited in the claims, and has misconstrued the prior art and applied it in a manner inconsistent with its own teachings,.

Furthermore, in the Advisory Actions of June 3 and July 15, 2003, the Examiner maintains the prior art rejections on the previously asserted grounds, as set forth in the final Official Action, without providing a reasonable response to the detailed traversal arguments, submitted in the Request for Reconsideration filed on April 30, 2003. These traversal arguments highlight those features and limitations which distinguish the present invention over the applied prior art, specifically identify positions taken by the Examiner which are contrary to the applied arts' own teachings, and explicitly requesting clarification of the Examiner's position. However, instead of providing a reasoned rebuttal to the traversal arguments, the response simply asserts the conclusion that the Examiner "does no[t] agree" with the traversal arguments, but provides no insight into why.

Claim 36 requires, *inter alia*, (i) storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) comparing a received routing number (associated with a financial institution at which a consumer maintains a deposit account) to the stored plurality of routing numbers (associated with the plurality of financial institutions) in the financial institutions file to verify accuracy of the received routing number.

As described by Braum in the Examiner referenced text in columns 11 and 12, a user enters an MICR encoded account number (which includes a routing number) at an ATM machine. This information is then routed to the user's financial institution. The account number is checked at that financial institution against stored information representing account numbers for accounts of only that financial institution, to verify the received account number. Hence, according to Braum, each financial institution only verifies its own account numbers, and therefore only its own routing number.

Also, as acknowledged by the Examiner, Braum fails to disclose (i) the required storage of a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number.

To overcome this deficiency, the Examiner proposes to modify Braum to include the claimed financial institutions file and to perform the comparison of a routing number received from a customer with the routing numbers associated with a plurality of financial institutions stored in such a file, in order to verify the accuracy of the received routing number, based on Paschal's disclosure of a directory of active and retired bank routing numbers published by Rand McNally.

The Examiner asserts that such a modification was obvious because it "would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is active or retired or incorrect routing number".

However, Braum has no need for a file corresponding to the Rand McNally directory, and therefore no need to store a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file. More particularly, Braum directs the received routing number for the customer's own financial institution to the customer's financial institution for verification. Hence, in the process described by Braum, a routing number for a particular customer financial institution is verified by only that financial institution.

The Examiner has neither proposed to modify Braum, nor identified anything within the applied prior art that suggests a modification of Braum, to verify the user entered account number at other than the user's financial institution. Hence, modification of Braum as proposed by the Examiner would result in each financial institution needlessly storing a plurality of routing numbers associated with a plurality of other financial institutions which it will never be called upon to verified (since according to a principle of operation of Braum, each financial institution only verifies it's own

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routing number).

Indeed, modifying Braum to incorporate the Rand McNally directory (or a corresponding file) as proposed by Examiner would result not only in unnecessary information being stored, but also in this unnecessarily stored information being searched at each financial institution. This would add additional expense and time to the processing being performed at each financial institute, without any corresponding benefit.

Braum's objectives include the reduction in the processing expense and time. Accordingly, the proposed modifications would result in Braum being unable to accomplish its stated objective.

Claim 40 requires, *inter alia*, that it be determined if the consumer financial institution accepts electronic fund transfers based on the verified routing number and, if so, that an instruction to pay the bill by electronic fund transfer from the consumer deposit account be generated.

The Examiner acknowledges that the base combination fails to disclose these limitations. The Examiner therefore proposes to modify the base combination in view of the teachings of Lawlor and Case to cure this deficiency.

In this regard, the Examiner asserts that Lawlor teaches that a determination is made as to whether or not the consumer financial institution accepts electronic fund transfers (citing column 10, line 66, through column 11, line 65).

However, contrary to the Examiner's assertion, as disclosed in the Examiner referenced text in column 11 of Lawlor, the financial institute maintaining the deposit account of the payer will always accept electronic fund transfers (via ATM). Indeed, in Lawlor, the debiting of the consumer's account is always performed via the ATM network, and therefore by an electronic fund transfer (EFT). This is a principle of operation of Lawlor and is necessary to meet Lawlor's objective.

More particularly, Lawlor discloses that a need existed for a practical architecture for providing comprehensive banking services, including paying bills to user selected payees, from one's home or office over standard telephone lines (see column 6, lines 31-36). According to Lawlor, home banking systems using standard PC's operating

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special purpose software have been unsuccessful for various reasons. Lawlor goes to great lengths to describe why existing systems, which do not utilize the existing ATM or ATM/POS networks, were unsuccessful (see column 1, line 20, through column 2, line 68, and column 6, lines 31-36).

In Lawlor's view, the need for a practical architecture can be met by capitalizing on the widespread familiarity with ATM and ATM/POS networks, and thereby avoiding training etc. which Lawlor viewed as otherwise necessary if ATM or ATM/POS networks were not utilized (see column 6, lines 45-55). Therefore, Lawlor has the explicit objective of providing bill paying services using the existing ATM and ATM/POS networks (see column 5, lines 8-19).

Lawlor proposes to meet this objective by disclosing a new use for the existing ATM and ATM/POS networks to provide transactions not previously supported by such networks, e.g. home initiated bill payment transactions and particularly the debiting of the payer's account in connection therewith (see column 7, lines 37-48).

Hence, Lawlor has no need for, and lacks any disclosure of, a determination of whether or not the consumer financial institution accepts EFT (see column 11, lines 43-55). However, even if it did, to the claim limitations would further require that this determination be made based on a verified routing number.

The Examiner asserts that Case teaches a determination as to whether or not the consumer's financial institution accepts electronic fund transfers, based on a verified routing number (citing column 4, line 61, through column 5, line 2). However, this is not the case.

According to Case (see column 4, line 26, through column 5, line 22), if electronic fund transfer (EFT) from the account holder's deposit account is desired, the account holder punches at the time of a transaction, or pre-punches, element 37, depicted in the portion of the draft detailed in Figure 3A,. There is nothing, and the Examiner has failed to identify any disclosure, within Case to suggest that a determination, as to whether or not to punch element 37, is made based on a routing number, let along a routing number after it has been verified. Additionally, Case discloses that if element 37 is punched, the account holder's deposit account is

automatically debited by electronic fund transfer (EFT), as disclosed in column 7, lines 53-56).

Furthermore, Case discloses that block 57, as depicted on the draft shown in Figure 3, contains the ABA routing number. However, Case fails to suggest that this routing number is verified.

Additionally, the Examiner asserts that it would have been obvious to those skilled in the art to modify the base combination "to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network and generate payment instructions via electronic funds transfer if feasible."

However, even if this were true, it does not address the claim 40 requirement that it be determined if the consumer financial institution accepts electronic fund transfers based on the verified routing number, or that that an instruction to pay the bill by electronic fund transfer from the consumer deposit account be generated if it is so determined.

As discussed above, Lawlor does not, and has no need to determine if the consumer financial institution accepts electronic fund transfers, since according to Lawlor the consumer's financial institution must accept electronic fund transfers (i.e. ATM transfers). This is a principle of operation of Lawlor, and required for Lawlor to meet its objectives. Therefore, Lawlor also has no need for limiting the generation of an instruction to pay the bill as required by claim 40.

Hence, the rejection has been based on a misunderstanding of that which is disclosed by applied prior art. Since the applied prior art has been misconstrued, it does provide the relied upon support for the Examiner's position. Accordingly, the rejection lacks the requisite objective support, and has effectively ignored express claimed limitations.

Claims 42-44, 46-48, 50-56, and 58-61 stand rejected on the same basis as the claim 40. Accordingly, it is respectfully submitted that the Examiner has likewise failed to establish a *prima facie* basis for the rejection of these claims for at least the reasons discussed above.

2. THERE IS NO MOTIVATION TO COMBINE THE ART AS PROPOSED BY THE EXAMINER

It is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966), **and** to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985). Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983).

As described by Braum in the Examiner referenced text in columns 11 and 12, a user enters an MICR encoded account number (which includes a routing number) at an ATM machine. This information is then routed to the user's financial institution. The routing number is checked against stored information representing account numbers for accounts at that financial institution, to verify the received routing number.

Hence, as acknowledged by the Examiner, Braum fails to disclose (i) the required storage of a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number of claim 36.

To overcome this deficiency, the Examiner proposes to modify Braum to include the required financial institutions file and to perform the comparison of a received routing number with the routing numbers stored in such a file in order to verify the

accuracy of the received routing number, based on Paschal's disclosure of a directory of active and retired bank routing numbers published by Rand McNally.

The Examiner asserts that it would have been obvious to modify Braum to include such a routing number directory and to compare a routing number entered at an ATM with the routing numbers in such a directory to verify the accuracy of the received routing number. The Examiner further asserts that this modification is motivated because it "would help to store the common data like routing numbers together for all financial institutions in one place and to include the updated information on the active and retired routing numbers so that any routing number received can be verified if it is active or retired or incorrect routing number".

However, Braum has no need for a file corresponding to the Rand McNally directory, and to modify the Braum to include the Rand McNally directory would result in the storage of the Rand McNally directory (or a corresponding file) at each financial institution, since according to Braum this is where the verification is performed. This in turn would result in the Braum system being made less efficient, since according to Braum each financial institution only verifies its own routing number, not the routing numbers of other financial institutions.

That is, Braum directs the routing numbers furnished by a customer only to the customer's own financial institution for verification. Hence, having each customer's own financial institution utilize the Rand McNally directory (or a corresponding file) would result in unnecessary information being stored and searched at each financial institution. This would also needlessly add additional expense and time to the processing being performed at each financial institute, which is inconsistent with Braum's objectives of reducing processing expense and time.

Furthermore, there is nothing in either of the applied art references to suggest the proposed combination, and the Examiner has failed to cite any disclosure with either of the base references that makes such a suggestion.

Although the Examiner states that it would be obvious to use the Rand McNally directory to verify the accuracy of a received routing number, based upon the objective evidence one might quite reasonably conclude that the applied art actually teaches

against the use of such a directory for such a purpose, and hence against the proposed combination and modification.

Further still, the Examiner baldly alleges that using such a directory would be beneficial because it would store routing numbers for different financial institutions which could be used to verify a received routing number in one place.

However, one can only ask why, in view of Braum's teaching that the verification of a routing number be performed by the financial institution to which that routing number relates. Indeed, contrary to the Examiner's assertion, the proposed modifications would result in Braum system becoming less efficient, with its processing made more time consuming and costly with no offsetting benefit.

With regard to claim 40, the Examiner acknowledges that the base combination fails to disclose the required (i) receiving of a request to pay a bill associated with a merchant on behalf of a consumer, (ii) determining if the consumer financial institute accepts electronic fund transfers based on the verified routing number, and (iii) generating of an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The Examiner therefore proposes to modify the base combination in view of the teachings of Lawlor and Case to cure this deficiency.

The Examiner asserts that it would have been obvious to those skilled in the art to modify the base combination "to combine the features of Lawlor of receiving requests to pay a bill with a merchant on behalf of the consumer via an ATM network and generate payment instructions via electronic funds transfer if feasible." The Examiner further asserts combining the art as proposed is motivated because "[d]oing so would benefit consumers to implement bill payments electronically from home and benefit payees by cutting down their processing costs, float, offering more predictable cash flow as explicitly disclosed by Lawlor".

However, Lawlor requires that all transfers from the payer's deposit account be by EFT (via ATM), so there is never an issue as to the feasibility of such transfers, and therefore Lawlor never addresses a question of feasibility. Rather, what Lawlor teaches

is that generating a payment instruction is not "feasible" if an EFT transfer from the payer's deposit account is not performed.

Furthermore, as disclosed in the Examiner referenced text in column 11, Lawlor teaches that the consumer's financial institute always accepts electronic fund transfers (via ATM). Hence, Lawlor has no need to determinate whether or not the consumer financial institution accepts EFT (see column 11, lines 43-55).

More particularly, as discused above, Lawlor is directed to capitalizing on the widespread familiarity with ATM and ATM/POS networks and avoiding training etc. which Lawlor viewed as otherwise necessary if ATM or ATM/POS networks were not utilized (see column 6, lines 45-55). An explicit objective and principle of operation of Lawlor is to provide bill paying services using the ATM and ATM/POS networks (see column 5, lines 8-19). Lawlor proposes to meet this objective by disclosing a new use of the existing ATM and ATM/POS networks to provide transactions not previously supported by such networks, e.g. home initiated bill payment transactions, and particularly the debiting of the payer's account via an ATM transfer in connection therewith (see column 7, lines 37-48). A substantial portion of the Lawlor patent is directed to describing the hardware and configuration of a specialized network device provided by Lawlor through which an instruction from a payer is transmitted. (See, for instance, column 6, lines 45-60, column 7, lines 5-11, and column 23, line 57, through column 29, line 48.) Lawlor's specialized device is intended to mimic an ATM machine and can only be utilized in delivering information to, and receiving information from, Lawlor's financial services distribution system. Hence, only payer's having an ATM deposit account can even access Lawlor's system, and therefore Lawlor has no need to make the determination of whether an ATM or other form of electronic fund transfer (EFT) can be performed, or to generate an instruction to pay based on such a determination as required, for example, in claim 40.

Furthermore, although the Examiner asserts that it was obvious to further modify the base combination (as modified by Lawlor) in accordance with Case to "include the feature of determining if electronic funds transfer can be made based on the verified routing numbers". However, as discussed in detail above, Case lacks any disclosure

whatsoever of determining if electronic funds transfer can be made based on the verified routing numbers.

Additionally, the Examiner alleges that the further modification based on Case is motivated because "[d]oing so would help the method of Braun/Paschal/Lawlor to determine if the payment is feasible by electronic funds transfer or via paper as suggested in both Lawlor (see at least col. 11, lines 55-60) and Case (col. 5, line 54-col. 6, line 9)". However, as discuss above in detail, using Lawlor there is no question of feasibility, and hence no need for such a determination, since Lawlor requires that transfers from the payer's deposit account are only made by electronic funds transfer, and never made via paper.

As claims 42-44, 46-48, 50-56, and 58-61 stand rejected on the same basis as the claims discussed above. Accordingly, it is respectfully submitted that the Examiner has likewise rejected these claims on the basis of a proposed combination of are which is unmotivated.

3. THE APPLIED REFERENCES FAIL TO SUGGEST THE CLAIMED INVENTION

In rejecting claims under 35 U.S.C. 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); In re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967). It also is incumbent upon the Examiner to provide a basis in fact and/or cogent technical reasoning to support the conclusion that one having ordinary skill in the art would have been motivated to combine references to arrive at a claimed invention. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In so doing, the Examiner is required to make the factual determinations set forth in Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 148 USPQ 459 (1966), and to provide a reason why one having ordinary skill in the art would have been led to modify the prior art reference to arrive at the claimed invention. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985).

Such a reason must stem from some teaching, suggestion or inference in the prior art as a whole or knowledge generally available to one having ordinary skill in the art.

Uniroyal, Inc. v. Rudkin-Wiley, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 227 USPQ 657 (Fed. Cir. 1985); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

In determining obviousness, the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed. Hartness Int'l, Inc. v. Simplimatic Eng'g Co., 819 F.2d 1100, 2 USPQ2d 1826 (Fed. Cir. 1987). It is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. In re Wesslau, 353 F.2d 238, 147 USPQ 391 (CCPA 1951). Piecemeal reconstruction of prior art patents is improper, In re Kamm, 452 F.2d 1052, 172 USPQ 298 (CCPA 1972). The Examiner must give adequate consideration to the particular problems and solution addressed by the claimed invention. Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990); In re Rothermel, 276 F.2d 393, 125 USPQ 328 (CCPA 1960).

The fact that the prior art could be modified so as to result in the combination defined by the claims does not make the modification obvious unless the prior art suggests the desirability of the modification. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986). The test is what the combined teachings would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 208 USPQ 817 (CCPA 1981). Simplicity and hindsight are not proper criteria for resolving obviousness, In re Warner, supra. Furthermore, as the Federal Circuit recently reiterated, reliance on common knowledge and/or common sense also cannot be the basis of finding obviousness (See

In re Lee 61 USPQ 2d 1430 (Fed. Circ. 2002)). The deficiencies in the applied art cannot be remedied by general conclusions which, in view of the disclosure in the present application, may appear to be common sensible.

The proper approach to the issue of obviousness is whether the hypothetical person of ordinary skill in the art, familiar with the references, would have found it obvious to make a structure corresponding to what is claimed. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Sernaker, 702 F.2d 989, 217 USPQ 1 (Fed. Cir. 1983). Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). The reference, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

Again, the issue is not whether it is within the skill of the artisan to make the proposed modification but, rather, whether a person of ordinary skill in the art, upon consideration of the references, would have found it obvious to do so. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986), In re Keller, supra. See In re Laskowski, F2d., 10 USPQ2d 1397 (CAFC 1989).

As has been discussed above, in the Examiner referenced text in columns 11 and 12, Braum discloses that a user enters an MICR encoded account number (which includes a routing number) at an ATM machine. This information is then routed to the user's financial institution. The routing number is checked by the user's financial institution against stored information representing account numbers for accounts maintained at that financial institution, to verify the received routing number.

Therefore, what Braum explicitly teaches is that a received routing number which is supposed to be associated with a particular financial institution is verified by that financial institution. Furthermore, as acknowledged by the Examiner, Braum fails to disclose (i) the required storage of a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) the required

comparing of a received routing number to the plurality of routing numbers stored in such a file to verify accuracy of the received routing number.

To overcome this deficiency, the Examiner proposes to modify Braum to include the required financial institutions file and to perform the comparison of a received routing number with the routing numbers stored in such a file in order to verify the accuracy of the received routing number, based on Paschal's general disclosure of a directory of active and retired bank routing numbers published by Rand McNally.

However, the Examiner has not cited any disclosure within Paschal, and it is respectfully submitted that Paschal lacks any disclosure, which suggests modifying Braum such that a received routing number that is supposed to be associated with a particular financial institution is verified by other than that financial institution, in contradiction of Braum's explicit teachings.

Furthermore, requiring each financial institution in Braum to maintain a financial institutions file storing a plurality of routing numbers associated with a plurality of financial institutions (e.g. a file corresponding to the Rand McNally directory of routing numbers), and to search such a file to verify only that a routing number, which is supposed to be associated with that particular financial institution, is in fact associated with it, would be detrimental, not beneficial, since it would needlessly add additional expense and time to the processing being performed at each financial institute, without a corresponding benefit and contrary to the objectives of Braum.

The Examiner also acknowledges that the base combination fails to disclose the required (i) receiving of a request to pay a bill associated with a merchant on behalf of a consumer, (ii) determining if the consumer financial institute accepts electronic fund transfers based on the verified routing number and (iii) generating of an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers, but proposes to modify the base combination in view of the teachings of Lawlor and Case to cure this deficiency.

However, as disclosed in the Examiner referenced text in column 11, Lawlor teaches that the consumer's financial institute must always accept electronic fund

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transfers (via ATM). Hence, Lawlor has no need for, and lacks any disclosure of, a determination of whether or not the consumer financial institution accepts electronic funds transfers (see column 11, lines 43-55). Indeed, Lawlor relies on each of the payers having prior experience making transfers from the payer's deposit account using the ATM network in order to meet its objectives.

Furthermore, in columns 4 and 5, Case discloses that the account holder punches or pre-punches element 37 on the draft (see the portion of the draft shown in Figure 3A) if electronic funds transfer is desired, and that block 57 of the draft (see Figure 3) contain the ABA routing number. As disclosed in column 7 of Case, an electronic funds transfer from the account holder's deposit account is automatically performed if element 37 is punched on the draft. Hence, there is no (and the Exmainer has failed to identify any) disclosure in Case of a verification of the routing number or a use of the routing number to determine whether or not to transfer funds from the account holder's deposit account by electronic funds transfer.

Additionally, any modification of Lawlor's teachings to require that the payer indicate whether or not ATM debiting is desired, would make no sense, since Lawlor requires, as a principle of its operation and in order to meet its objectives, that ATM debiting of the payer's account be utilized for all payments.

Therefore, it is respectfully submitted that the applied prior art lacks any teaching or suggestions of the following claimed features:

The claim 36 (i) storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file, and (ii) comparing of a received routing number associated with a financial institution at which a consumer maintains a deposit account to the stored plurality of routing numbers in the financial institutions file to verify accuracy of the received routing number.

The 38 rejecting of the received routing number if the accuracy is not verified because the received routing number does not correspond to one of the stored plurality of routing numbers in the financial institutions file.

The claim 39 use of the comparison to also verify that the received routing number is entered correctly.

The claim 40 (i) determining if the consumer financial institution accepts electronic fund transfers based on the verified routing number, and (ii) generating an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The claim 42 (i) comparing of the received routing number associated with a financial institution at which the consumer maintains a deposit account to routing numbers associated with a plurality of financial institutions in a financial institutions file to verify the accuracy of the received routing number, (ii) determining if the consumer financial institution accepts electronic fund transfers based on the verified routing number; and (iii) generating of an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The claim 43 (i) storing of a plurality of routing numbers associated with a plurality of financial institutions in a financial institution database, (ii) comparing of a routing number associated with a financial institution to the plurality of routing numbers in the financial institution database to verify correctness of the routing number, and (iii) determining if the financial institution accepts electronic fund transfers based on the verified routing number.

The claim 44 (i) storage device configured to store a plurality of routing numbers associated with a plurality of financial institutions, and (ii) processor configured to compare a routing number associated with a financial institution at which a consumer maintains a deposit account to the stored plurality of routing numbers, and thereby verify correctness of the consumer financial institution routing number.

The claim 46 processor which is further configured to reject the consumer financial institution routing number if the consumer financial institution routing number does not correspond to one of the stored plurality of routing numbers and is therefore not verified.

The claim 47 verification which also verifies correctness of the entry of the consumer financial institution routing number.

The claim 48 processor which is further configured (i) to determine if the

consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and (ii) to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The claim 50 (i) database of routing numbers associated with a plurality of financial institutions, and (ii) processor configured (1) to compare a routing number associated with a financial institution at which the consumer maintains a deposit account to the database of routing numbers and thereby verify that the consumer financial institution routing number is correct, (2) to determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and (3) to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The claim 51 (i) storage device configured to store a plurality of routing numbers associated with a plurality of financial institutions, and (ii) processor configured to verify accuracy of a routing number associated with a financial institution by comparing the routing number to the stored plurality of routing numbers and to determine if the financial institution accepts electronic fund transfers based on the verified routing number.

The claim 52 computer programming which causes a computer to operate so as to (i) compare a routing number associated with a financial institution at which a consumer maintains a deposit account to a plurality of routing numbers associated with a plurality of financial institutions, and (ii) verify that the consumer financial institution routing number is correct based on the results of the comparison.

The claim 53 computer programming which causes the computer to store the plurality of routing numbers in a financial institutions file.

The claim 54 computer programming which causes the computer to reject the consumer financial institution routing number if the consumer financial institution routing number is determined not to correspond to any of the plurality of routing numbers based on the comparison.

The claim 55 computer programming which causes the computer to receive the consumer financial institution routing number based on an input and to also verifies correctness of the input.

The claim 56 computer programming which causes the computer to (i) determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and (ii) generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The claim 58 computer programming which causes the computer to (i) compare a routing number associated with a financial institution at which the consumer maintains a deposit account to a database of routing numbers associated with a plurality of financial institutions to verify accuracy of the consumer financial institution routing number, (ii) determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and (iii) generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

The 59 computer programming which causes the computer to (i) store a plurality of routing numbers associated with a plurality of financial institutions in a database, (ii) compare a routing number associated with a financial institution to the plurality of routing numbers in the database, (iii) verify the accuracy of the routing number based on the comparison, and determine if the financial institution accepts electronic fund transfers based on the verified routing number.

The claim 60 (i) determining if the consumer financial institution accepts electronic fund transfers based on a received routing number associated with a financial institution at which the consumer maintains a deposit account, and (ii) generating of an instruction to debit the consumer deposit account by electronic fund transfer if the consumer financial institution is determined to accept electronic fund transfers, in order to process the received pay request.

The claim 61 (i) storing of a plurality of routing numbers associated with a plurality of financial institutions, and (ii) comparing the received routing number to the stored

plurality of routing numbers to verify accuracy of the received routing number, such that the determination is made based on the verified received routing number.

4. THE REJECTION IS BASED ON EITHER AN IMPROPER HINDSIGHT RECONSTRUCTION OF THE INVENTION BASED ON THE APPLICATIONS OWN TEACHINGS OR ON PURE SPECULATION

Hindsight obviousness after the invention has been made is not the test. In re Carroll, 601 F2d 1184, 202 USPQ 571 (CCPA 1979). A reference or combination of references, viewed by itself and not in retrospect, must suggest doing what applicant has done. In re Shaffer, 229 F2d 476, 108 USPQ 326 (CCPA 1956); In re Skoll, 523 F2d 1392, 187 USPQ 481 (CCPA 1975).

Inherency requires certainty, not speculation. In re Rijckaert, 9 F.3rd 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); In re King, 801 F.2d 1324, 231 USPQ 136 (Fed. Cir. 1986); W. L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); In re Oelrich, 666 F.2d 578, 212 USPQ 323 (CCPA 1981); In re Wilding, 535 F.2d 631, 190 USPQ 59 (CCPA 1976). Objective evidence must be relied upon to defeat the patentability of the claimed invention. Ex parte Natale, 11 USPQ2d 1222 (BPAI 1988).

As discussed in detail above, the appealed claims have been rejected without objective factual support or rational. The prior art cited in support of the rejections has been applied in a manner inconsistent with its own teachings. A combination has been asserted for which no motivation exist. Express limitations and features set forth in the claims have been effectively ignored. The Examiner's position that the present claims are obvious over the applied prior art is unsupported by the evidence. Hence, at best, it can only be concluded that the prior art rejection of the claims, as set out in the final Official Action, reflects either an improper hindsight reconstruction of the invention based on the teachings of the subject application itself or pure speculation on the part of the Examiner.

CONCLUSION

It is respectfully submitted that the Examiner (i) has failed to establish a prima facie case for the rejection, (ii) has proposed to combine art in a manner which is unmotivated, (iii) has failed to apply art which teaches or suggests the claimed invention, and (iv) has attempted to improperly reconstruct the invention using the inventors own disclosure or relied on pure speculation in rejecting the claims. Thus, the rejection of the pending claims as obvious under 35 U.S.C. §103(a) over the applied prior art, whether taken individually or in any combination, is improper.
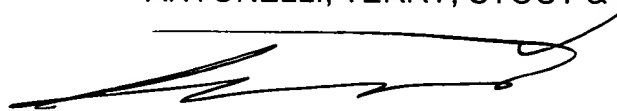
In summary, Applicants respectfully submit that the applied references do not teach or suggest features recited in each of the rejected independent claims, as well as those recited in a number of the dependent claims. Furthermore, the proposed combinations of the applied references are themselves unmotivated and therefore improper. It is submitted that the art does not provide any teaching, or suggestion within its teachings, which would lead to the features or advantages of the instant invention, and the claims patentably define over the art.

Thus, the rejection of the pending claims under 35 USC §103(a) is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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APPENDIX OF CLAIMS UNDER APPEAL

36. A method for processing consumer banking information, comprising:

storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institutions file;

receiving a routing number associated with a financial institution at which a consumer maintains a deposit account; and

comparing the received routing number to the stored plurality of routing numbers in the financial institutions file to verify accuracy of the received routing number.

38. The method of claim 36, further comprising:

rejecting the received routing number if the accuracy is not verified because the received routing number does not correspond to one of the stored plurality of routing numbers in the financial institutions file.

39. The method of claim 36, further comprising:

entering the received routing number; and

wherein the comparison also verifies that the received routing number is entered correctly.

40. The method of claim 36, further comprising:

receiving a request to pay a bill associated with a merchant on behalf of the consumer;

determining if the consumer financial institution accepts electronic fund transfers based on the verified routing number; and

generating an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

42. A method for paying bills, comprising:

receiving a request to pay a bill associated with a merchant on behalf of a

consumer and a routing number associated with a financial institution at which the consumer maintains a deposit account;

comparing the received routing number to routing numbers associated with a plurality of financial institutions in a financial institutions file to verify the accuracy of the received routing number;

determining if the consumer financial institution accepts electronic fund transfers based on the verified routing number; and

generating an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

43. A method for determining if a financial institution can process electronic fund transfers, comprising:

storing a plurality of routing numbers associated with a plurality of financial institutions in a financial institution database;

comparing a routing number associated with a financial institution to the plurality of routing numbers in the financial institution database to verify correctness of the routing number; and

determining if the financial institution accepts electronic fund transfers based on the verified routing number.

44. A system for processing consumer supplied banking information, comprising:

a storage device configured to store a plurality of routing numbers associated with a plurality of financial institutions; and

a processor configured to compare a routing number associated with a financial institution at which a consumer maintains a deposit account to the stored plurality of routing numbers, and thereby verify correctness of the consumer financial institution routing number.

46. The system of claim 44, wherein the processor is further configured to reject the

consumer financial institution routing number if the consumer financial institution routing number does not correspond to one of the stored plurality of routing numbers and is therefore not verified.

47. The system of claim 44, further comprising:

a data entry device for entering the consumer financial institution routing number;

wherein the verification also verifies correctness of the entry of the consumer financial institution routing number.

48. The system of claim 44, further comprising:

a network interface configured to receive a request to pay a bill associated with a merchant on behalf of the consumer;

wherein the processor is further configured to determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

50. A system for paying bills, comprising:

a network interface configured to receive a request to pay a bill associated with a merchant on behalf of a consumer;

a database of routing numbers associated with a plurality of financial institutions; and

a processor configured (i) to compare a routing number associated with a financial institution at which the consumer maintains a deposit account to the database of routing numbers and thereby verify that the consumer financial institution routing number is correct, (ii) to determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number, and (iii) to generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic

fund transfers.

51. A system for determining if a financial institution accepts electronic fund transfers, comprising:

a storage device configured to store a plurality of routing numbers associated with a plurality of financial institutions; and

a processor configured to verify accuracy of a routing number associated with a financial institution by comparing the routing number to the stored plurality of routing numbers and to determine if the financial institution accepts electronic fund transfers based on the verified routing number.

52. An article of manufacture for paying bills, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

compare a routing number associated with a financial institution at which a consumer maintains a deposit account to a plurality of routing numbers associated with a plurality of financial institutions; and

verify that the consumer financial institution routing number is correct based on the results of the comparison.

53. The article of manufacture according to claim 52, wherein the computer readable medium is further readable to cause the computer to:

store the plurality of routing numbers in a financial institutions file.

54. The article of manufacture according to claim 52, wherein the computer readable medium is further readable to cause the compute to:

reject the consumer financial institution routing number if the consumer financial

institution routing number is determined not to correspond to any of the plurality of routing numbers based on the comparison.

55. The article of manufacture according to claim 52, where the computer readable medium is further readable to cause the computer to:

receive the consumer financial institution routing number based on an input;

wherein the verification also verifies correctness of the input.

56. The article of manufacture according to claim 52, wherein the computer readable medium is further readable to cause the computer to:

receive a request to pay a bill associated with a merchant on behalf of the consumer;

determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number; and

generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

58. An article of manufacture for paying bills, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

receive, via a network, a request to pay a bill associated with a merchant on behalf of a consumer;

compare a routing number associated with a financial institution at which the consumer maintains a deposit account to a database of routing numbers associated with a plurality of financial institutions to verify accuracy of the consumer financial institution routing number;

determine if the consumer financial institution accepts electronic fund transfers based on the verified consumer financial institution routing number; and

generate an instruction to pay the bill by electronic fund transfer from the consumer deposit account if the consumer financial institution is determined to accept electronic fund transfers.

59. An article of manufacture for determining if a financial institution can process electronic fund transfers, comprising:

a computer readable medium; and

computer programming stored on the medium;

wherein the stored computer programming is configured to be readable from the computer readable medium by a computer to thereby cause the computer to operate so as to:

store a plurality of routing numbers associated with a plurality of financial institutions in a database;

compare a routing number associated with a financial institution to the plurality of routing numbers in the database;

verify the accuracy of the routing number based on the comparison; and

determine if the financial institution accepts electronic fund transfers based on the verified routing number.

60. A method for processing a payment request, comprising:

receiving a request to pay a bill associated with a merchant on behalf of the consumer and a routing number associated with a financial institution at which the consumer maintains a deposit account; and

determining if the consumer financial institution accepts electronic fund transfers based on the received routing number, and generating an instruction to debit the consumer deposit account by electronic fund transfer if the consumer financial institution is determined to accept electronic fund transfers, in order to process the received pay request.

61. The method according to claim 60, further comprising:

storing a plurality of routing numbers associated with a plurality of financial institutions; and

comparing the received routing number to the stored plurality of routing numbers to verify accuracy of the received routing number;

wherein the determination is made based on the verified received routing number.